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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/535,979 | 03/27/2000 | Tomasz Duczmal | 856.1043 | 4057 |

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| EXAMINER |
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NGUYEN, NHON D

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| ART UNIT | PAPER NUMBER |
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2179

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|----------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 09/535,979 | Applicant(s) DUCZMAL ET AL. | |
| | Examiner Nhon (Gary) D Nguyen | Art Unit 2179 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to amendment, filed 12/22/2004.
2. Claims 1, 6-9 and 11-16 are pending in this application. Claims 1 and 11 are independent claims. In this amendment, no claim is canceled, no claim is amended, no and claim is added.

This action is made final.

Response to Declaration under 37 C.F.R. 1.131

3. The Declaration under 37 CFR 1.131 filed on 03/07/2005 has been considered but is ineffective to overcome the Binder reference.

Claims or Claims limitation is not comprehended by the exhibits:

Nowhere in the Exhibits A-D mentions “at least one billboard located in a public space accessible by the public for displaying to the public said at least one image object during said allocated time slot and, *prior to expiry of said allocated time slot, triggering a communication session with said server to upload and display a further image object during a respective further time slot*” as recited in claims 1 and 11. Claims do not appear to be supported by the evidence provided in the Exhibits A-D. It means that there is not enough evidence to clearly prove the relationship between the Exhibits A-D and the Claims. Therefore, claims 1, 6-9 and 11-16 remain rejected.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6-9, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (US 6,430,605) in view of Binder (US 6,513,052).

As per independent claim 1, Hunter teaches a system for dynamic display of advertising material, comprising:

a plurality of input sources for receiving scheduling information and advertising material in the form of at least one image object for scheduling display of said advertising material during an allocated time slot (col. 3, lines 43-65);

a database for storing said at least one image object; a server for managing said advertising material in accordance with said scheduling information (col. 3, lines 53-58); and

at least one billboard located in a public space accessible by the public for displaying to the public said at least one image object during said allocated time slot (col. 3, lines 31-42).

Hunter teaches prior to expiry of said allocated time slot, *the server triggering a communication session with the billboard* to upload and display a further image object during a respective further time slot (col. 3, line 43 – col. 4, line 12). However, Hunter does not disclose *the billboard triggers a communication session with the server* to upload and display image object during a respective further time slot. A client schedules to trigger communication sessions with a server to download or upload data is well known in the client-server computer art. Binder teaches a client computer automatically trigger, by a scheduling mechanism, a communication

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session with a storage server for archiving data over the Internet (col. 5, lines 8-22). It would have been obvious to an artisan at the time of the invention to use the teaching from Binder of triggering communication sessions with a server by a client in Hunter's system since it would allow the clients actively control the flow of the transferring data.

As per claim 6, which is dependent on claim 1 Hunter teaches the server comprises:
a distribution engine for uploading said scheduling information and said advertising material from said plurality of input sources, for managing said advertising material and for providing said advertising material to said at least one display location (col. 4, lines 4-12); and

Since the *Review Schedule and Purchase Time* module (60 of fig. 1) schedules the advertising time slot (col. 3, lines 53-58), it is inherent that the *Review Schedule and Purchase Time* module has a slot allocator for monitoring said scheduling of said display.

As per claim 7, which is dependent on claim 6, Hunter teaches the server further comprises: a transaction system for enabling payment, cancellations and status checking (col. 3, lines 47-50 and col. 5, lines 32-34).

As per claim 8, which is dependent on claim 1, it is inherent in Hunter's system that the server further comprises a monitoring system for providing a view of said advertising material, allocated to a display location, to at least one of said plurality of input sources.

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As per claim 9, which is dependent on claim 7, Hunter teaches the server further comprises:

a location identifier for providing description, statistical and technical information concerning said at least one display location to at least one of said plurality of input sources (col. 4, line 47 – col. 5, line 34).

As per independent claim 11, Hunter teaches a method for dynamic display of advertising, comprising:

accessing a server, via said network, to retrieve available time slots associated with at least one billboard; selecting a time slot from said available time slots for displaying advertising material (col. 3, lines 53-58);

storing said advertising material in a database (col. 3, lines 53-58);

uploading said advertising material from said database to said billboard prior to occurrence of said selected time slot (col. 3, lines 43-65);

displaying said advertising material to the public at said billboard located in a public space accessible by the public when said timeslot occurs (col. 3, lines 31-42); and

Hunter teaches prior to expiry of said allocated time slot, *the server triggering a communication session with the billboard* to upload and display a further image object during a respective further time slot (col. 3, line 43 – col. 4, line 12). However, Hunter does not disclose *the billboard triggers a communication session with the server* to upload and display image object during a respective further time slot. A client schedules to trigger communication sessions with a server to download or upload data is well known in the client-server computer art. Binder

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teaches a client computer automatically trigger, by a scheduling mechanism, a communication session with a storage server for archiving data over the Internet (col. 5, lines 8-22). It would have been obvious to an artisan at the time of the invention to use the teaching from Binder of triggering communication sessions with a server by a client in Hunter's system since it would allow the clients actively control the flow of the transferring data.

As per claims 12 and 13, which are dependent on claims 11 and 12 respectively, Hunter teaches the step of searching for a billboard before said step of selecting a time slot from said available time slots and further comprising the step of retrieving billboard location data after said step of searching for a billboard location (col. 3, lines 53-58).

As per claim 14, which is dependent on claim 11, Hunter teaches the step of checking said advertising material for technical integrity before said step of storing said advertising material in "said" database (col. 4, lines 4-12).

As per claims 15-16, Hunter teaches the step of performing financial transactions before said step of uploading said advertising material (col. 3, lines 53-63), wherein the step of performing financial transactions comprises the steps of calculating transaction fees and aggregating airtime information (col. 4, line 47 – col. 5, line 34).

Response to Arguments

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6. Applicant's arguments filed 12/22/2004 have been fully considered but they are not persuasive.

Applicant argued the following:

(a) There is no teaching or suggestion in the prior art supporting the combination of Binder and Hunter.

(b) The combination of Binder with Hunter would destroy the purpose of Hunter.

Examiner disagrees for the following reasons:

(a) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hunter already teaches prior to expiry of said allocated time slot, *the server triggering a communication session with the billboard (or client)* to upload and display a further image object during a respective further time slot (col. 3, line 43 – col. 4, line 12). However, Hunter does not disclose *the billboard (or client) triggers a communication session with the server* to upload and display image object during a respective further time slot. A client schedules to trigger communication sessions with a server to download or upload data is well known in the client-server computer art. Binder is used here as a secondary reference to teach a client computer automatically trigger, by a scheduling mechanism, a communication session

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with a storage server for archiving data over the Internet (col. 5, lines 8-22). It would have been obvious to an artisan at the time of the invention to use the teaching from Binder of triggering communication sessions with a server by a client in Hunter's system since it would allow the clients actively control the flow of the transferring data.

(b) As mentioned above, Hunter's reference teaches a server triggers a communication session with a client to upload and display image content at allocated time slot (col. 3, line 43 – col. 4, line 12 and col. 10, line 61 – col. 11, line 3). Hunter does not disclose a client scheduled to trigger communication sessions with a server to download or upload data. However, since a client scheduled to trigger communication sessions with a server to download or upload data is well known in the client-server computer art, Hunter's system could have been easily modified to have a client (billboard) scheduled to trigger communication sessions with a server to download or upload image content. Binder is used as a secondary reference to prove that a client scheduled to trigger communication sessions with a server to download or upload data is well known in the art. Therefore, The combination of Binder with Hunter would not destroy the purpose of Hunter, which is displaying image content on a specified billboard at an allocated time slot.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is (571)272-4139. The examiner can normally be reached on Monday - Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571)272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nhon (Gary) Nguyen
April 13, 2005


BA HUYNH
PRIMARY EXAMINER